IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1949.

No. 822.

GEORGE R. ERICSON and CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

No. 822.

OTTO HENNING and CARTER CARBURETOR CORPORATION,

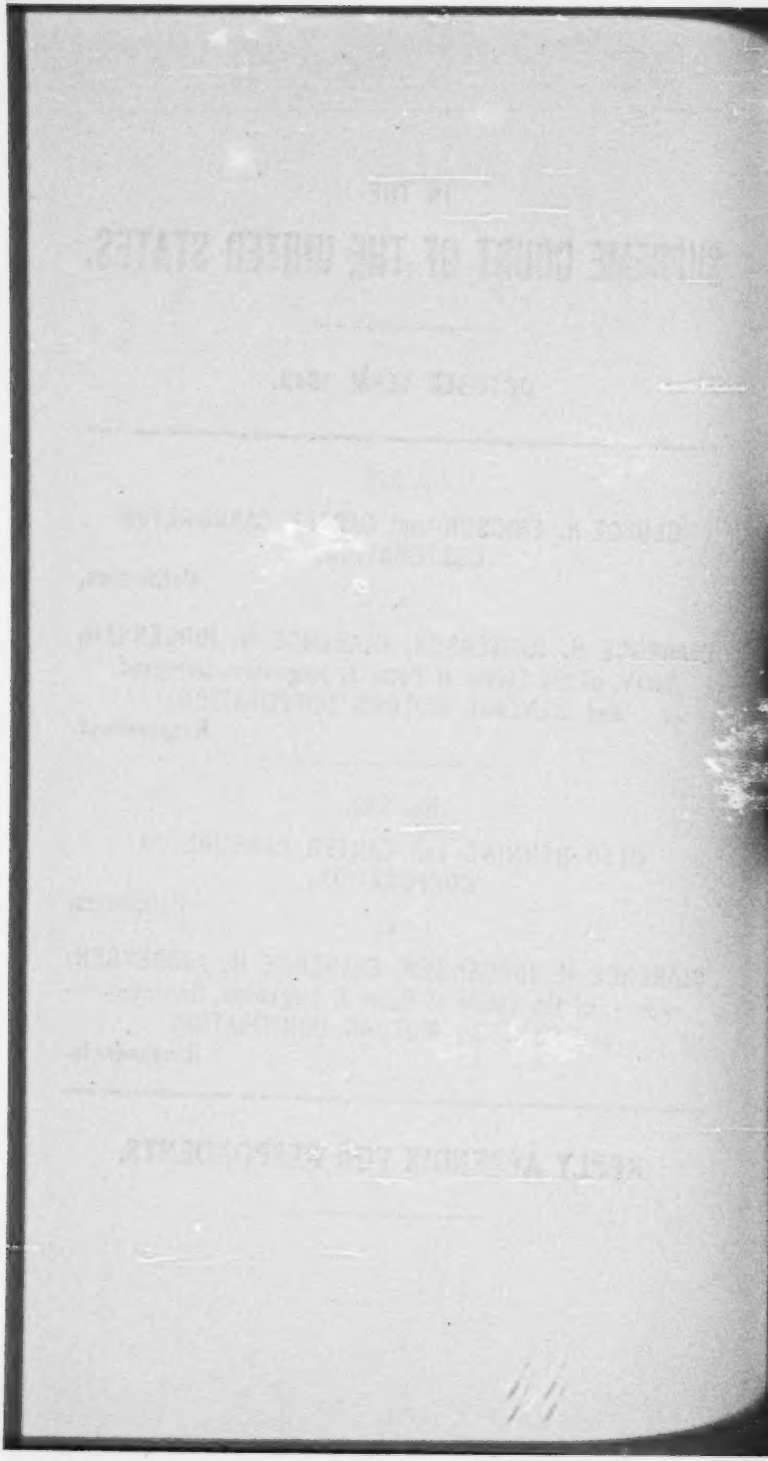
Petitioners,

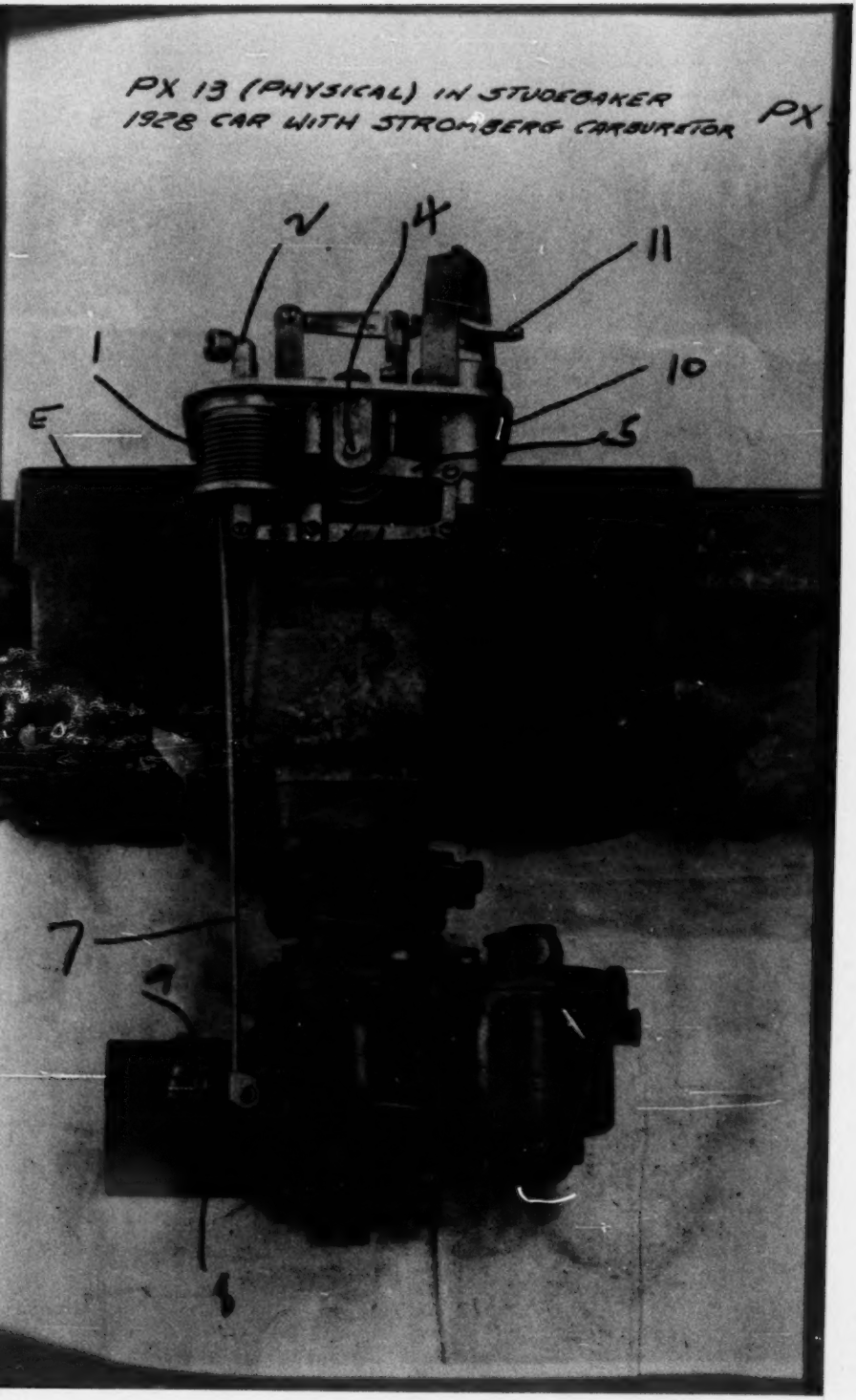
v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

REPLY APPENDIX FOR RESPONDENTS.




PX 13 (PHYSICAL) IN STUDEBAKER
1928 CAR WITH STROMBERG CARBURETOR
PX
2
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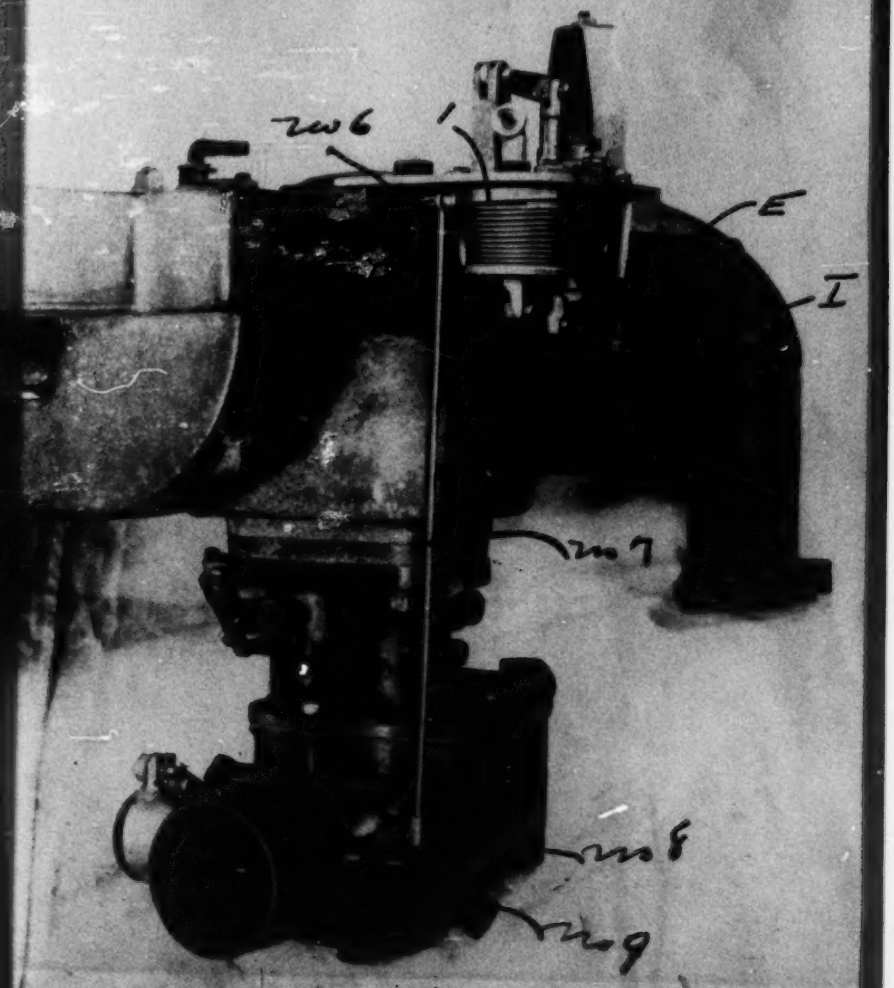
PX 13 (PHYSICAL) IN STUDEBAKER

1928 CAR WITH STROMBERG CARBURETOR

PX 10



Engrav. Nos. 78346-78886-80733,
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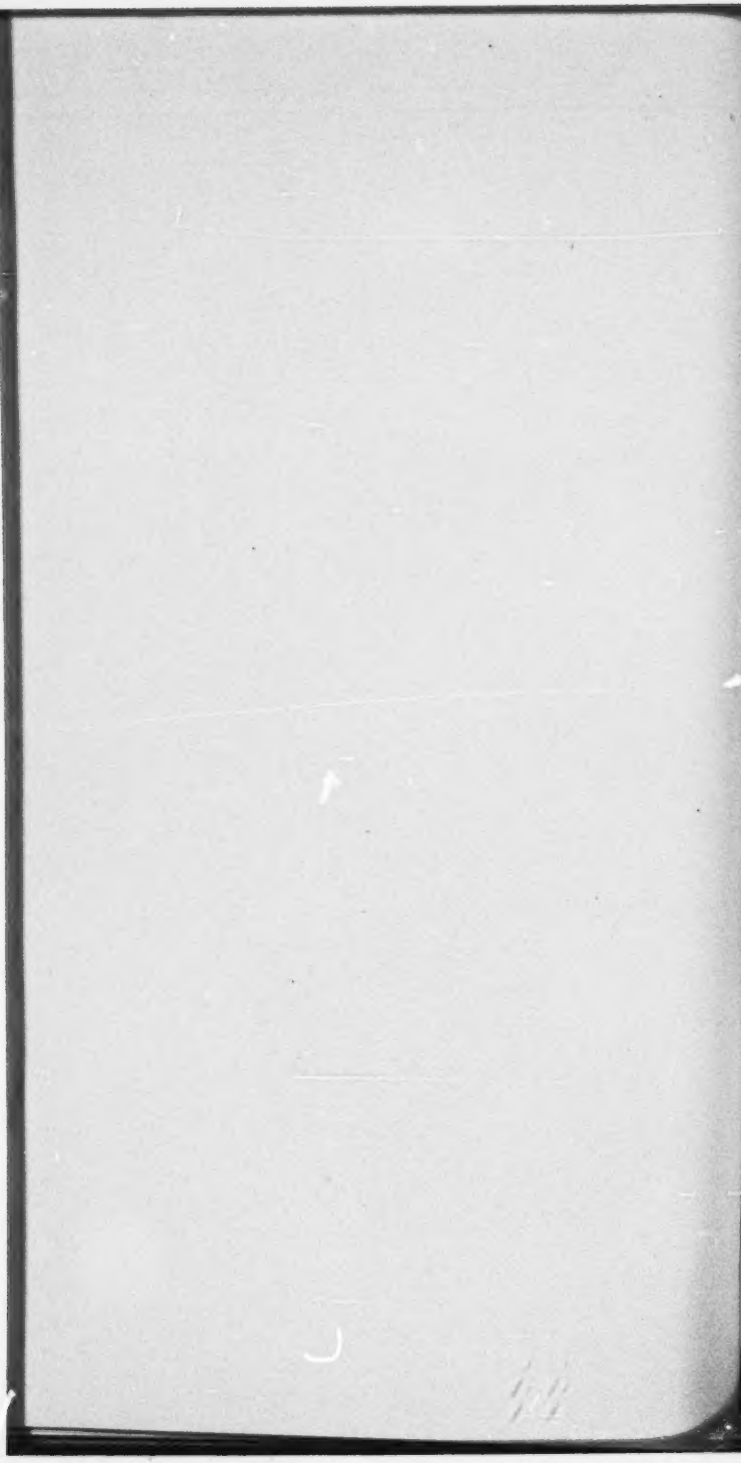
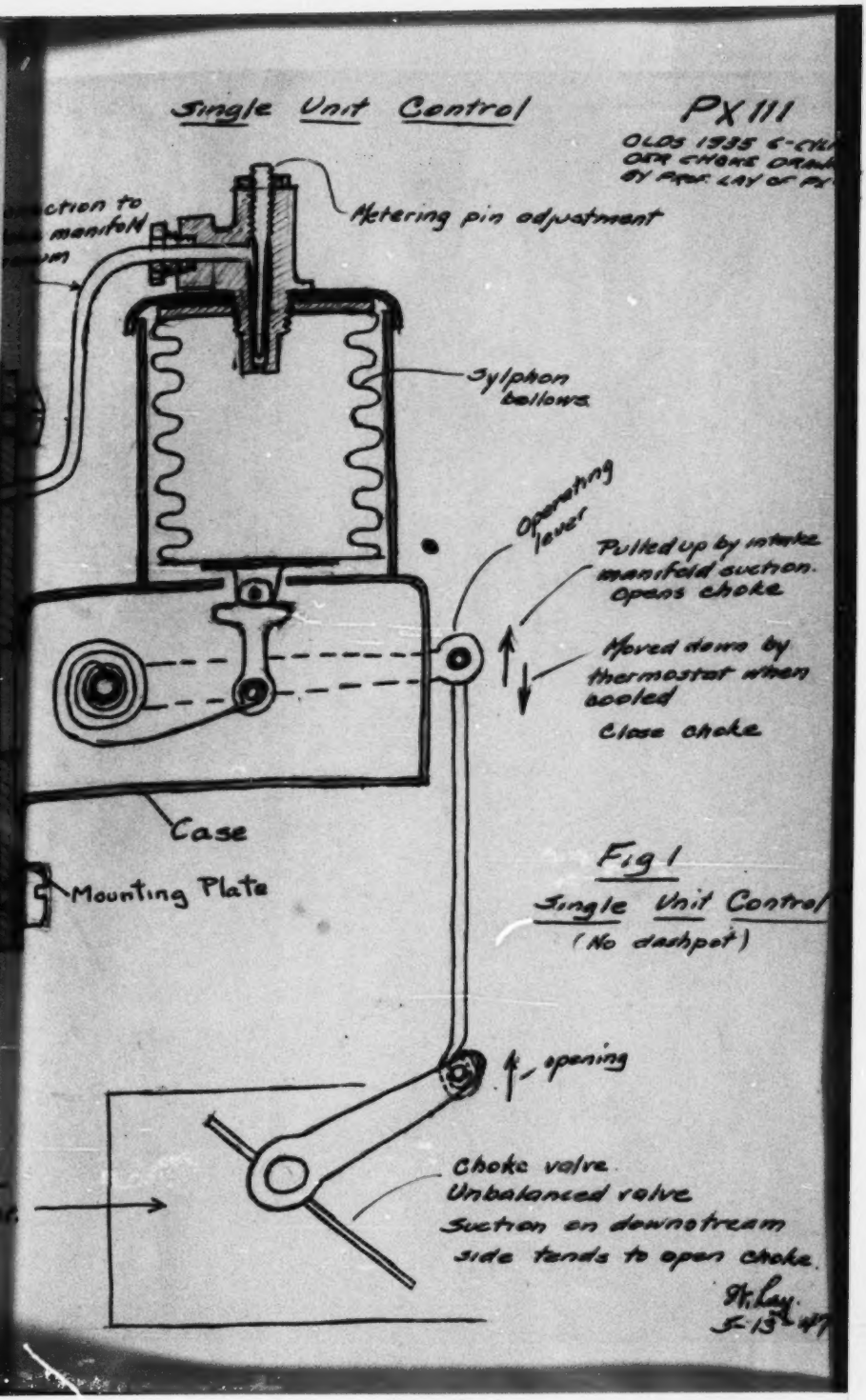
U. S. Treaker, V. E. Fischer
Engr. Pub. Co. Montgomery Co., Pa.




Single Unit Control
PX 111
OLDS 1935 6-CYL
OTT CHOKE DRAW
BY PROF. LAY OF PU
ction to
manifold
on
Metering pin adjustment
Sylphon bellows
Operating lever
Pulled up by intake manifold suction. Opens choke
Moved down by thermostat when cooled
Close choke
Case
Mounting Plate
Fig 1
Single Unit Control
(No dashpot)
opening
Choke valve
Unbalanced valve
Suction on downstream side tends to open choke.
H. Lay
5-13-47

[fol. 114] In the District Court of the United States,
Eastern District of Missouri,
Eastern Division.

Clarence H. Jorgensen, Clarence H. Jorgensen, Adm'r, and General Motors Corporation, Plaintiffs, vs. Otto Henning and Carter Carburetor Corporation, Defendants.	Civil Action 4544 For Issuance of a Patent (R. S. 4915) Intf. 78,345
Clarence H. Jorgensen, Clarence H. Jorgensen, Adm'r, and General Motors Corporation, Plaintiffs, vs. George R. Ericson and Carter Carburetor Corporation, Defendants.	Civil Action 4545 For Issuance of a Patent (R. S. 4915) Intf. 80,733

Findings of Fact.

1. The cases are suits under Section 4915 of the Revised Statutes, 35 U. S. C. A. 63, as it existed when these suits were filed on April 30, 1946, after decisions and judgments dated Oct. 31, 1945, adverse to Plaintiffs and in favor of Defendants in Patent Office Interferences Nos. 78,345 and 80,733, respectively, awarding priority of invention to Defendants in both Interferences.[1] No appeal has been taken by Plaintiffs to the Court of Customs and Patent Appeal from either of said decisions in either of said Interferences.[2] The cases were tried together in this Court.[3]

2. Plaintiff, Clarence H. Jorgensen, is a resident of Fairport, New York, and Plaintiff, General Motors Cor- [fol. 115] poration is a Delaware corporation; Plaintiffs

1 R. II, 463, 481 2 R. I, 5, 8; 17, 20 3 R. I, 22, 57

are such in both causes Civil Action Nos. 4544 and 4545. Otto Henning, Defendant in Civil Action No. 4544, is a resident of Clayton, Missouri, George R. Ericson, Defendant in Civil Action 4545 is a resident of Kirkwood, Missouri, and Carter Carburetor Corporation, Defendant in both civil actions 4544 and 4545, is a Delaware corporation licensed to do business in Missouri and has a regular and established place of business at St. Louis, Missouri, where it maintains its general offices and factory.[1]

3. The applications of the parties were filed in the Patent Office on the following dates:

Clarence H. Jorgensen and Peter J. Jorgensen (Deceased), filed January 8, 1932, Serial No. 585,510;[2]

Otto Henning filed November 17, 1931, Serial No. 575,577;[3]

George R. Ericson, filed November 6, 1931, Serial No. 573,418.[4]

The Jorgensens' application was involved in both Interferences 78,345 and 80,733. The Henning application was involved in Interference 78,345, and the Ericson application was involved in Interference 80,733.[5]

General Motors Corporation is the owner by direct assignment of the Jorgensen application but that application is still pending. The Henning and Ericson applications were assigned to Defendant, Carter Carburetor Corporation, to whom the patents issued, as follows:

Henning Patent No. 2,421,733, granted June 3, 1947;[6]

Ericson Patent No. 1,915,851, granted June 27, 1933[7] and reissued as Re. No. 22,742 on April 9, 1946.[8]

The counts involved in the Jorgensen-Henning Interference are claims 89, 90, 91, 92 and 94 in the Jorgensen application, the first of which was introduced therein by amendment November 4, 1939 (PX 1-A, Paper No. 50),[9] and the remaining four by amendment of March 11, 1941 (PX 1-A, Paper No. 54).[10] The single count involved in the Jorgensen-Ericson Interference is claim 95 in the Jorgensen application which was added by amendment of January 27, 1943 (PX 1-A, Paper No. 60).[11]

1 R. I, 1-26
2 R. II, 931
3 R. II, 889, 905
4 R. II, 835
5 R. II, 463, 481
6 R. II, 905
7 R. II, 835
8 R. II, 863
9 R. II, 1025
10 R. II, 1029
11 R. II, 1035

[fol. 116] 4. The Complaints in each of these causes were filed on April 30, 1946;[1] the Answers in both of these causes were filed on June 20, 1946;[2] on May 28, 1947 Plaintiffs filed in each of these causes a Motion for Leave to Amend the original Complaint, which Motions were granted on May 29, 1947;[3] on June 2, 1947, Defendants filed their Answer to Plaintiffs' Amendment to Plaintiffs' Complaint in each of these causes.[4] A motion to dismiss was filed by Defendants, prior to the introduction of evidence, attacking the jurisdiction of the Court, and the Motion was taken under consideration for determination with the cases.[5]

5. These cases proceeded to trial before this Court on testimony in open Court, on certain of the depositions and parts thereof offered before the Patent Office in Interference 80,733, on Exhibits including certain of the exhibits before the Patent Office in Interference 80,733 and on the decisions of the Patent Office in Interferences 78,345 and 80,733.[6] No testimony was taken in Interference 78,345 by Defendants.[7]

6. The issues in these cases involve the question of priority of invention as between Clarence H. Jorgensen and Peter J. Jorgensen (deceased) on the one hand and Otto Henning on the other hand in Interference 78,345; and between Clarence H. Jorgensen and Peter J. Jorgensen (deceased) on the one hand and George R. Ericson on the other hand in Interference 80,733; all for the inventions defined in the counts involved in said Interferences and set out in the paragraph 9 of the Complaints. The common subject-matter of the claims embodied in the interference proceedings were determined by the Patent Office.[8]

7. The subject-matter in issue relates generally to an internal combustion engine equipped with a carburetor and with an automatic primer or choke to facilitate starting the engine and operating it before it becomes warmed up. The claims in issue are of the combination type. Some of them are to the engine-carburetor-automatic primer or choke combination and others are to the carburetor-automatic primer or choke combination.[9]

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1 R. I, 6, 18
2 R. I, 10, 23
3 R. I, 11, 24
4 R. I, 12, 25
5 R. I, 59, 424
6 R. II, 463, 481
7 R. II, 483
8 R. II, 475, 481
9 R. II, 463, 481

[fol. 117] 8. At the trial of this suit, plaintiffs introduced the testimony of Clyde R. Paton[1] and Gilbert D. Williams,[2] who testified to certain facts concerning the construction and use of the device in controversy. Their testimony was not before the Patent Office Tribunal. The witnesses were available and their testimony could have been obtained for submission to the Board; but there is no substantial suggestion that their testimony was concealed or deliberately withheld.[3] The war was on and those engaged in mechanical production were busy. Plaintiff Clarence H. Jorgensen had not talked to these witnesses for many years prior to the hearing.[4]

9. Prior to 1927 Plaintiff, Clarence H. Jorgensen and his father, Peter J. Jorgensen, who died in 1928, designed and patented primers and chokes for automobile engines and a device to control the water temperature in an automobile engine.[5] In October 1927 they constructed and applied to their Buick automobile a primer which was provided with an automatic device for supplying a rich mixture direct to the intake manifold upon starting, the rich mixture being cut off after the engine had started and had reached operating temperature.[6] This device was in operation from October 1927 until August 1928. At that time the Buick car to which the device was attached was sold and the device removed.[7] The device operated satisfactorily in cold weather during that period.[8] This device was lost after its removal from the Buick and could not be produced either at the interference hearing or at the trial of this suit.[9] It indicates the theory of the device which plaintiffs were attempting to develop. The question of whether the specific primer installed on the Buick automobile in 1927, was the sole invention of Clarence H. Jorgensen or the joint invention of the Jorgensens, was not passed upon in the decisions of the Board of Interference Examiners,[10] nor pleaded in the Defendants' Answers,[11] and cannot now be urged by the Defendants in these cases.

[fol. 118] 10. On October 20, 1928, the Jorgensens acquired a 1928 Studebaker automobile equipped with a Schebler carburetor[12] and almost immediately after receiving the

1 R. I, 317
2 R. I, 291
3 R. I, 326, 308
4 R. I, 308, 327
R. I, 221, 228
5 R. I, 182, 186, 336
6 R. I, 189-194, 337-343
7 R. I, 194; PX 5, R. II, 499
8 R. I, 194, 342
9 R. I, 194, 413-414
10 PX 1B; R. II, 463-491
11 R. I, 6, 12, 18, 25
12 PX 5, R. II, 499; R. I, 199; R. I, 346, 318

Studebaker, Jorgensen installed on it the choke-controlling mechanism identified as Plaintiffs' Exhibit 13 produced in Court[1] and comprising: (1) A heat responsive motive device in the form of a thermostat which is of spiral form and located to be heated from the exhaust manifold; (2) A suction responsive device in the form of a bellows which itself forms a spring and which is connected by pipe connection to the intake manifold so as to respond to the changes in the suction therein; (3) A joint connection from the thermostat and the bellows to the choke valve of the carburetor, viz., to the operating arm of the choke valve shaft, through a link to the end of the thermostat, through the thermostat shaft to an arm thereon and through that arm to the bellows.[2] The device so installed on the Studebaker automobile worked satisfactorily.[3] The device used upon the Studebaker automobile was again demonstrated in December 1943 in the presence of the parties to this suit in temperatures of 22° F. and proved to be satisfactory.[4] Plaintiffs' physical Exhibit 13 includes a dash pot[5] and remnant of a solenoid locking device which latter is not now connected up.[6] Originally the dash pot was connected, but later it was disconnected.[5]

11. This Court finds that the existence, construction and operation of the Jorgensens' Studebaker choke controlling mechanism, Pl. Ex. 13, including a dash pot which was originally connected but later disconnected, as applied to a 1928 Studebaker car equipped with a Schebler carburetor, was established as early as October 1928; that the mechanism so applied operated the air choke valve to secure a rich mixture at starting and with the engine cold, and with leaning out of the mixture when the engine started and further leaning out as the engine heated up;[7] [fol. 119] that the Studebaker car so equipped operated successfully in cold weather during the Winter of 1928-1929[8] and established the correctness of the principle of operation of that mechanism; and that said choke-controlling mechanism embodies the subject-matter of Count 1 set forth in paragraph 9 of the Complaint in C. A. 4545.[9]

12. Later, when the 1929 model Studebaker came out they were equipped with Stromberg carburetors, and with manifolds designed for such carburetors.[10] The Jorgensen

1 R. I, 199, 350, 319
2 R. I, 200-201, 320, 348
3 R. I, 221, 321, 354
4 R. I, 395-399
5 R. I, 204, 206, 325, 351
6 R. I, 228
7 R. I, 199, 208-213
8 R. I, 222-223, 319-321, 353-354
9 R. II, 475
10 R. I, 223-224, 347

1928 Studebaker car was equipped with such a carburetor and its manifold and their device, Plaintiffs' Exhibit 13, including a dash pot which was however disconnected, attached [ot] it; that was before Christmas 1929.[1] That device remained on the car until in July 1930, when the Jorgensens no longer had possession of the car, at which time the device was removed.[2]

13. This Court finds that the existence, construction and operation of the Jorgensens' Studebaker choke controlling mechanism Plaintiffs' Exhibit 13, including a dash pot which was however disconnected, as applied to a 1928 Studebaker car equipped with a Stromberg carburetor, was established as early as Christmas, 1929;[3] that the mechanism so applied operated the air choke valve to secure a rich mixture at starting and with the engine cold, and with leaning out of the mixture when the engine started and further leaning out as the engine heated up; that the Studebaker car so equipped operated successfully in cold weather during the Winter of 1929-1930[4] and established the correctness of the principle of operation of that mechanism; and that said choke-controlling mechanism embodies the subject-matter of Counts 1, 2, 3, 4 and 5 set out in paragraph 9 of the Complaint in C. A. 4544[5] and of Count I set forth in paragraph 9 of the Complaint in C. A. 4545.[6]

[fol. 120] 14. After July 1930 the Jorgensens had a laboratory but no manufacturing facilities, and their funds were tied up in a bank for a number of years. Automobile sales also dropped off during 1930, 1931 and 1932. In 1930 the Jorgensens contacted the Wilcolator Company and made an agreement with that company to manufacture the Jorgensen automatic choke controlling mechanism in quantities and market it, but that company had financial reversals in 1931. Jorgensen proceeded to redesign the device to get the cost down, and Jorgensen visited a number of the automobile companies in 1930 and 1931 to interest them in the device.[7] The Jorgensens' application was filed January 8, 1932.[8]

15. This Court finds with the Patent Office that Defendant, Henning, did not conceive or reduce to practice the

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1 R. I, 229, 355-356
2 R. I, 229-230, 294
3 R. I, 229, 355-356
4 R. I, 236-237, 229, 302, 356
5 R. I, 416-419
6 R. II, 475
7 R. I, 243-248
8 R. II, 931

subject-matter of Counts 1, 2, 3, 4 or 5, set forth in paragraph 9 of the Complaint in C. A. 4544 prior to the filing of his application on November 17, 1931.[1]

16. This Court finds with the Patent Office that Defendant Ericson did not actually reduce to practice the subject-matter of Count 1, set forth in paragraph 9 of the Complaint in C. A. 4545 prior to the filing of his application on November 6, 1931;[2] that Defendant Ericson conceived the subject-matter of said Count 1 after said Jorgensens had conceived and reduced to practice the subject-matter of said Count 1; and that any conception by Ericson of the subject-matter of said Count 1 in the fall of 1929, given by the Patent Office,[3] is unimportant.

[fol. 121] 17. The dash pot on Plaintiffs' physical Exhibit 13 was identified by Plaintiff Jorgensen and by Plaintiffs' Witnesses Paton and Kyser.[4] Plaintiffs' Witness Williams recognized the dash pot but was not familiar with its action.[5] The dash pot was originally connected when the mechanism was used with the Schebler carburetor but it was later disconnected when the mechanism was used with either the Schebler or with the Stromberg carburetor. The dash pot was not needed on the mechanism when used with either a Schebler or a Stromberg carburetor.[6] A solenoid locking device referred to by Jorgensen was an experimental unit placed on the intake of the carburetor; it was not originally put on Plaintiffs' Exhibit 13 but at a later date and then for a very short time because not needed; it is not connected up in Plaintiffs' Exhibit 13; the witnesses other than Jorgensen did not identify such a solenoid locking device.[7]

18. The Jorgensens had given an automatic choke study for a number of years and were jointly working along that line. What they were trying to do was to find means that would serve the requirements necessary to start and to run an automobile engine, particularly when cold, entirely automatically. The early part of 1927 they felt that they had the necessary requirements in mind that would make it possible to make a fully automatic choke, sensing the difference between cranking and running,

1 R. II, 483
2 R. II, 477
3 R. II, 477
4 R. I, 203-207, 324-325, 350-351
5 R. I, 310
6 R. I, 204-206, 324-325, 350-351
7 R. I, 228

by employing a suction device and a thermostatic metal to control or modify either the fuel or the air side of the carburetor.[1]

[fol. 122] Conclusions of Law.

I. This is a suit under R. S. 4915, 35 U. S. C. A. 63, and this Court had jurisdiction of the subject-matter and of the parties.

II. In this suit under Section 4915 of the Revised Statutes, 35 U. S. C. A. 63 as it existed when these suits were filed on April 30, 1946, the issue is one to determine the question of priority of invention as between Plaintiffs and Defendants.

III. The allegations of the original Complaints clearly stated a cause of action, the jurisdiction of which was in the District Court. It was unnecessary for the pleader, in referring to Title 35, Section 63, U. S. C. A. (Rev. Stat. 4915), to add the explanatory words as to when the act had been amended. It was not necessary to confer jurisdiction on the Court to mention the section of the statute under which it was brought. It was not necessary for the pleader to quote the words of the statute providing when suit may be brought by an applicant who had been denied a patent. The amendments to the Complaints were unnecessary, but having been made, they simply stated more clearly and spelled out in greater detail that which was already sufficient. The motion of the defendants to dismiss for lack of jurisdiction is overruled.

IV. In this suit under R. S. 4915 it was not necessary that all nor any of the evidence before the Patent Office [fol. 123] be presented to this Court. It was the intent of Congress that the parties might introduce the whole or any part of the evidence heard by the Patent Office Tribunal for consideration and it is to be given "the same force and effect as if originally taken and produced in the suit." (Chapter 273, Sec. 11, 44 Stat. 1336, March 2, 1927.) The right is given to the parties to take further testimony, unless the withholding of the evidence before

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1 R. I, 187-189

the Patent Office was willful or was concealed or deliberately withheld. There was no such withholding or concealment and the contention of Defendants in that respect is overruled.

V. This Court concludes that the Jorgensens' Studebaker choke controlling mechanism, Plaintiffs' physical Exhibit No. 13, combined with a Stromberg carburetor on a 1928 Studebaker car, constituted before Christmas 1929 and during the Winter of 1929-1930, a conception and reduction to practice of that combination and of the subject-matter of Counts 1, 2, 3, 4, and 5 as set forth in paragraph 9 of the Complaint in Civil Action 4544.

VI. This Court concludes that the Jorgensens' Studebaker choke controlling mechanism, Plaintiffs' physical Exhibit No. 13 in combination with a Schebler carburetor on a 1928 Studebaker car, constituted in October 1928 and during the Winter of 1928-1929 and until Christmas 1929, and in combination with a Stromberg carburetor on such a car, before Christmas 1929 and during the Winter of 1929-1930, conceptions and reductions to practice of those combinations and of the subject-matter of Count 1 as set forth in paragraph 9 of the Complaint in Civil Action 4545.

VII. This Court concludes that Defendant, Henning did not conceive or reduce to practice the subject-matter of Counts 1, 2, 3, 4 and 5 as set forth in paragraph 9 of [fol. 124] the Complaint in C. A. 4544 before he filed his application on November 17, 1931, or before Clarence H. Jorgensen and Peter J. Jorgensen, conceived and reduced to practice the subject-matter of said Counts.

VIII. This Court concludes that Defendant, Ericson, did not conceive or reduce to practice the subject-matter of Count 1 set forth in paragraph 9 of the Complaint in C. A. 4545 before Clarence H. Jorgensen and Peter J. Jorgensen conceived and reduced to practice the subject-matter of said Count.

IX. This Court concludes that Clarence H. Jorgensen and Peter J. Jorgensen are the original, first and joint in-

ventors of the subject-matter of Counts 1, 2, 3, 4 and 5 set forth in Paragraph 9 of the Complaint in Civil Action 4544, and of Count 1 set forth in paragraph 9 of the Complaint in Civil Action 4545.

X. This Court concludes that Clarence H. Jorgensen and Peter J. Jorgensen having reduced to practice the subject-matter of the Counts set forth in [paragraphs] 9 of the Complaint, were not required to be diligent in the filing of their application.

XI. Plaintiffs are entitled to an award of priority of the Counts 1, 2, 3, 4 and 5 set forth in Paragraph 9 of the Complaint in Civil Action 4544, and of Count 1 set forth in Paragraph 9 of the Complaint in Civil Action 4545, and the Commissioner of Patents is authorized to issue such patent to Plaintiffs upon filing in the Patent Office copy of the adjudication and otherwise complying with the requirements of law.

XII. Plaintiffs are entitled to their costs and disbursements in this proceedings.

Feb. 11, 1949.

R. M. DUNCAN,
United States District Judge.